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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,583	05/30/2000	Toni Kopra	017.38081X00	8331

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EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,583

Applicant(s)

KOPRA, TONI

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19,21-34 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) 42-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19,21-34 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Amendment***

This office action is in response to amendment filed September 15, 2004. Claims 1, 28, 33, 34, 36, 41 have been amended. New claims 42-44 have been added. Claims 20 and 35 have been cancelled. Claims 19, 21-34, 36-41 are now pending in this application. Claims 42-44 are withdrawn from consideration.

Election/Restrictions

Newly submitted claims 42-44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions of Group I (claims 19, 21-34, 36-41) and Group II (claims 42-44) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because receiving a video signal, examining the video signal to find a predefined video image, embedding a link to a resource within the video signal, sending or enabling transmission and display of the video signal at the mobile terminal; displaying the video image at the terminal so that the link is displayed in proximity to the predefined video image, independently claimed in the subcombination group II is not a limitation of the independently claimed combination of group I. The subcombination has separate utility such as receiving a video signal, examining the video signal, and embedding a link to a resource with the video signal. Examiner considers that since applicant independently

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claim the invention of this group, it is prima facie showing that the inventions are intended to be independently and distinct and are shown to be separately usable.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 42-44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 19, 21-24, 28, 29, 34-39 and 41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bandera et al. U.S. Patent No. 6,332,127.

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Regarding claims 19, 21 and 22 and 24, Bandera teaches displaying a link to a resource with a mobile terminal; automatically employing the location of the mobile terminal to determine content that is related to the linked resource and also to the location of the terminal; determining the location at periodic interval; searching a database for sellers information (see abstract, col. 2 lines 29-53, col. 5 lines 15-25 and col. 6 line 41 to col. 7 line 52).

Regarding claim 23 determining the network address of the mobile terminal and mapping the network address to mobile identifier is inherent feature of Bandera's access to Internet (see col. 4 lines 36-45).

Regarding claims 28 and 29, Bandera teaches transceiver configured to communicate over a network; a memory including logical instructions stored therein and a processor configured to enable action based on executing the logical instruction for displaying a link to a resource; storing the location of the mobile terminal and communication the selected link and the location of the mobile terminal to an application server; receiving content related to the linked resource and the location and displaying the content (see fig. 2, abstract, col. 2 lines 29-53, col. 5 lines 15-25 and col. 6 line 41 to col. 7 line 52).

Regarding claims 37-39, Bandera teaches searching database for reseller information that is a match to the location of the terminal and advertisement and providing the information to the mobile terminal (see fig. 2&3 and col. 4 line 35 to col. 5 line 25). Base station subsystem and mobile terminal connected via GSM network is inherent feature.

Claim 41 is rejected as stated above in claim 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-27, 30-33 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera and further in view of Saha et al. U.S. Patent No. 6,198,935.

Regarding claims 25-27, 30-33 and 40 Bandera teaches the location of the mobile terminal being determining using different method, such GPS, or based on identification of the cellular base station or satellite beam (see col. 4 lines 46-60 and col. 6 line 42 to col. 7 line 30). Bandera does not explicitly teach measuring radio signals and determining the arrival time of a first detectable path and determining idle periods; , it is taught by Saha (see abstract and col. 5 line 15 to col. 6 line 67 and col. 7 lines 5-23). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bandera's mobile terminal with Saha's determining of position based upon network characteristics. One would be motivated to include signal measurement for the purpose of computing an accurate position of a mobile station, as taught by Saha (see col. 7 lines 5-10). Bandera's Web access from the mobile terminal enables a bet from the mobile terminal.

Response to Arguments

Applicant's arguments filed September 15, 2004 have been fully considered but they are not persuasive. Applicant argues that the prior art does not teach the content be determined as a result of selecting the link and not by default. The prior art teaches providing a web page (link to

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a resource), when user selects the web page (link), the user location is determined and advertisement is selected based on the user's location and/or time and the advertisement is provided to be displayed with the web page. Applicant states that the claim discloses a location-related content associated with the resource. Examiner would like to point out that the claim recites, the step of "automatically employing the location of the mobile terminal". The rest of the limitation "to determined content that is related to the linked resource and also related to the location of the mobile terminal" is intended use only. Therefore, the prior art teaches the claimed feature of displaying link, determining a selection of the link, automatically determining the location of the terminal as a result of the selection of the link, automatically employing the location of the mobile terminal and enabling the mobile terminal to display the related content.

Regarding the rejection under "103", applicant argues that Saha does not disclose displaying content related to a linked resource on a mobile terminal upon selection of the link by a user Examiner would like to point out those limitations are taught by Bandera not by Saha. The Examiner depended on Saha for the teaching of "measuring radio signals and determining the arrival time of a first detectable path and determining idle periods". Applicant's amendment to the claims have over come the "101" and the "112" rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yehdega Retta
Primary Examiner
Art Unit 3622

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